

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Ricks/Ryan

Mailed: April 8, 2004

Opposition No. 91104472 (parent)
Opposition No. 91104529
Opposition No. 91104905

THE TRUSTEES OF COLUMBIA
UNIVERSITY IN THE CITY OF
NEW YORK

v.

COLUMBIA/HCA HEALTHCARE CORPORATION

Karyn K. Ryan, Interlocutory Attorney
Trademark Trial and Appeal Board.

A review of the record for this proceeding reveals that this case has been suspended for some time to permit the parties an opportunity to settle their dispute. Inasmuch as there has been no word from either party concerning the status of their negotiations since July 2, 2003, it is concluded that efforts to reach an amicable settlement in this case have been unsuccessful.

Accordingly, proceedings herein are **RESUMED** and trial dates, including the close of discovery, are reset as follows:

THE PERIOD FOR DISCOVERY TO CLOSE: July 12, 2004

30-day testimony period for party
in position of plaintiff to close: October 10, 2004

30-day testimony period for party
in position of defendant to close:

December 9, 2004

15-day rebuttal testimony period to close: January 23, 2005

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b).

An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

Each party is allowed thirty days from the mailing date hereof to serve its responses to any outstanding discovery requests that its adversary may have served prior to the suspension period.

**GOOD CAUSE REQUIRED FOR FUTURE EXTENSIONS, EVEN IF
CONSENTED; PARTIES MUST PROVIDE DETAILED PROGRESS REPORT TO
JUSTIFY FURTHER DELAYS**

This proceeding commenced over seven years ago. As we review the record, we observe a series of consented motions to suspend and/or extend discovery filed over the course of five years. We are concerned with the number of extensions requested in this case and the absence of detailed

information in the record regarding the progress the parties have made toward settlement or towards completing discovery.

The standard for allowing an extension of a prescribed period prior to the expiration of that period is "good cause." See Fed. R. Civ. P. 6(b) and the discussion and authorities cited in TBMP §403.04 and 509. Whether to grant a motion to extend falls squarely within the Board's discretion. See Fed. R. Civ. P. 6(b). The Board generally is liberal in granting extensions of time so long as the moving party has not been guilty of negligence or bad faith and the privilege of extensions is not abused. See, e.g., *American Vitamin Products Inc. v. Dow Brands Inc.*, 22 USPQ2d 1316 (TTAB 1992); and *Sunkist Growers, Inc. v. Benjamin Ansehl Company*, 229 USPQ 147 (TTAB 1985). Additionally, while the Board encourages settlement discussions and will allow parties to extend proceedings in furtherance of legitimate settlement efforts, at some point, the Board in the exercise of its proper discretion, will require the parties to show progress of those negotiations to justify further extensions.

To the extent the parties seek to further extend or suspend this proceeding to engage in settlement negotiations, the moving party (or parties) will be expected to establish good cause for any further extensions or suspension herein, to report on the progress of their settlement talks, and to provide detailed factual information upon which the Board could conclude that good cause exists to further extend or

suspend the time for taking discovery. See Fed. R. Civ. P. 6(b) and Trademark Rule 2.117(c). A settlement progress report should include: a recitation of issues that have been resolved or substantially resolved, a statement of issues in this proceeding that remain to be resolved, dates of past settlement meetings (including whether the meetings were held in person or via teleconference), dates of when drafts of settlement proposals have been exchanged, dates of scheduled future settlement meetings, and a firm timetable for resolution of all outstanding matters in this proceeding.

Should the parties seek additional time to conduct discovery or to respond to discovery requests, the parties will be expected to establish good cause for any further extensions of discovery herein, to report on the progress of discovery, and to provide detailed factual information upon which the Board could conclude that good cause exists to further extend the time for conducting discovery. See Fed. R. Civ. P. 6(b). A discovery progress report should include information regarding all past and planned depositions, written discovery requests, and written responses to discovery requests. Moreover, the moving party should provide dates of past discovery activities, as well as a firm timetable for completion of discovery.

Absent the appropriate detailed progress report(s), future motions to extend or suspend may not be approved, even though consented by the parties or uncontested. Inasmuch as

the Board has been more than generous in approving extensions in this case, the parties are forewarned that the Board will not approve future motions to extend or suspend based on mere consent and/or generalized statements of the progress of the parties' activities. Nor will we approve future extension requests absent a showing of diligent efforts¹ on the part of both parties. The Board will scrutinize carefully future motions to extend or suspend in determining whether good cause has been shown.

Notice Regarding TTAB Electronic Resources and New Rules

TTAB forms for electronic filing of extensions of time to oppose, notices of opposition, and inter partes filings are now available at <http://estta.uspto.gov>. Images of TTAB proceeding files can be viewed using TTABVue at <http://ttabvue.uspto.gov>.

Parties should also be aware of changes in the rules affecting trademark matters, including rules of practice before the TTAB. See Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act, 68 Fed. R. 55,748 (September 26, 2003) (effective November 2, 2003) Reorganization of Correspondence and Other Provisions, 68 Fed. Reg. 48,286 (August 13, 2003) (effective September 12, 2003). Notices concerning the rules changes are available at www.uspto.gov.

The second edition of the Trademark Trial and Appeal Board Manual of Procedure (TBMP) has been posted on the USPTO web site at www.uspto.gov/web/offices/dcom/ttab/tbmp/.

¹ While we might consider a generalized statement that the parties are continuing settlement negotiations or need additional time to conduct discovery as good cause for a proposed extension during the early stages of litigation, the parties are forewarned that the Board, in the future, may not find such generalizations sufficient to warrant future extensions in this case, which was instituted over seven years ago. To justify prolonging this case any further, the parties will be expected to show that they have been diligently engaged in either litigating or negotiating settlement of this case.